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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/049,695 03/27/98 BILLING-MEDEL F 6066.US.PI

023492
ABBOTT LABORATORIES
DEPT. 377 - AP6D-2
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ABBOTT PARK IL 60064-6050

HM12/0925

EXAMINER

CANELLA, K

ART UNIT

PAPER NUMBER

1642

DATE MAILED:

09/25/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/049,695

Applicant(s)

Billing-Medel et al

Examiner

Kar n Canella

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-- The MAILING DATE of this communication appears on the front cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 months MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) ☐ Responsive to communication(s) filed on _____

2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.

3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 35 C.D. 11; 453 O.G. 213.

Disposition of Claims

4) ☒ Claim(s) 7-10, 13, 14, 16, and 19-33 is/are pending in the application

4a) Of the above, claim(s) 7-10, 13, 14, 16, and 19-27 is/are withdrawn from consideration

5) ☐ Claim(s) _____ is/are allowed.

6) ☒ Claim(s) 28-33 is/are rejected.

7) ☐ Claim(s) _____ is/are objected to.

8) ☐ Claims _____ are subject to restriction and/or election requirements.

Application Papers

9) ☐ The specification is objected to by the Examiner.

10) ☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved.

12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

13) ☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

a) ☐ All b) ☐ Some* c) ☐ None of:

1. ☐ Certified copies of the priority documents have been received.

2. ☐ Certified copies of the priority documents have been received in Application No. _____.

3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

*See the attached detailed Office action for a list of the certified copies not received.

14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

15) ☒ Notice of References Cited (PTO-892)

18) ☐ Interview Summary (PTO-413) Paper No(s). _____

16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)

19) ☐ Notice of Informal Patent Application (PTO-152)

17) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s). _____

20) ☐ Other: _____

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DETAILED ACTION

1. The request filed on August 1, 2001 for a Continued Prosecution Application (CPA) under 37 CFR 1.53(d) based on parent Application No. 09/049,625 is acceptable and a CPA has been established. An action on the CPA follows.
2. Claims 1-3 have been canceled. Claims 28-33 have been added. Claims 7-10, 13, 14, 16 and 19-33 are pending. Claims 7-10, 13, 14, 16 and 19-27 remain withdrawn from consideration. Claims 28-33 are examined on the merits.
3. The rejection of the pending claims under 35 U.S.C. 101 will not be made after consideration of the Declaration of Philip Hemken under 37 C.F.R. 1.132, filed August 16, 2001.

Claim Rejections - 35 USC § 112

4. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.
5. Claims 28-33 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for SEQ ID NO:1, 2 and 25, does not reasonably provide enablement for SEQ ID NO:23 and 24. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to use the invention commensurate in scope with these claims. Claims 28-32 are drawn in part to the polynucleotides of SEQ ID NO:23 and 24. However, there is no textual reference to these SEQ ID Nos, beyond their incorporation by reference, nor are these sequences put forth in any figure in the instant application. The specification does not teach that the ESTs of SEQ ID NO:23 and 24 were used to derive the

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consensus sequence of SEQ ID NO:5, or were related to the full length sequence of SEQ ID NO:4. Given this lack of guidance in the specification, one of skill in the art would not know how to use the claimed SEQ ID NO:23 and 24 polynucleotides.

Claim Rejections - 35 USC § 102

6. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371© of this title before the invention thereof by the applicant for patent.

7. Claims 28-32 are rejected under 35 U.S.C. 102(e) as being anticipated by Lal et al (US 5,856,139). Claims 28 and 31 are drawn in part to the polynucleotide sequences comprising SEQ ID NO:2 or 25. Claims 29 and 32 embody the nucleic acid as produced by recombinant techniques. Claims 30 and 33 embody the nucleic acid as being produced by synthetic techniques. Lal et al disclose a polynucleotide comprising SEQ ID NO:2. Lal et al further disclose that this polynucleotide comprises a species of SEQ ID NO:25, as the polynucleotide of the instant invention has a "N" at position 8, and as the polynucleotide disclosed by Lal et al has a "C" at position 8. Lal et al further teach the polynucleotide comprising both SEQ ID NO:2 and 25 as being produced synthetically or recombinantly.

Conclusion

8. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Karen Canella whose telephone number is (703) 308-8362. The examiner can normally be reached on Monday through Friday from 8:30 am to 6:00 pm. A message may be left on the examiner's voice mail service. If attempts to reach the examiner by telephone are

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unsuccessful, the examiner's supervisor, Anthony Caputa, can be reached on (703) 308-3995.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 308-0196.

Karen A. Canella, Ph.D.

Patent Examiner, Group 1642

September 21, 2001


ANTHONY C. CAPUTA
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